

**IN THE MATTER OF AN OPPOSITION by E.I. du Pont de Nemours and Company to application No. 664,659 for the trade-mark QUATTREL filed by The Governor and Company of Adventurers of England trading into Hudson's Bay, also known as Hudson's Bay Company**

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On August 17, 1990, the applicant, The Governor and Company of Adventurers of England trading into Hudson's Bay, also known as Hudson's Bay Company, filed an application to register the trade-mark QUATTREL based upon proposed use of the trade-mark in Canada in association with **“comforters, duvets, cushions and pillows; insulated interlining for mens’, ladies’ and children’s winter apparel and insulated fill for sleeping bags”**.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of November 11, 1992 and the opponent, E.I. du Pont de Nemours and Company, filed a statement of opposition on February 5, 1993, a copy of which was forwarded to the applicant on March 15, 1993. As its first ground of opposition based on Paragraph 12(1)(d) of the *Trade-marks Act*, the opponent alleged that the applicant’s trade-mark QUATTREL is not registrable in that it is confusing with its registered certification marks COMFOREL, registration No. 382,410 as applied to pillows, QUALLOFIRM, registration No. 354,684 covering pillows, comforters, and batting filler, and QUALLOFIL, registration No. 291,001, covering pillows, batting filler and insulations. The second ground is based on Paragraph 16(3)(a) of the *Act*, the opponent alleging that the applicant is not the person entitled to registration of the trade-mark QUATTREL in that, as of the applicant’s filing date, the applicant’s mark was confusing with its certification marks: COMFOREL which had previously been used in Canada in relation to pillows by licensee(s) of the opponent; QUALLOFIRM which had previously been used in Canada in relation to pillows, comforters, and batting filler; QUALLOFIL which had previously been used in Canada in relation to pillows, batting filler and insulations; QUALLOLOFT which had previously been used in Canada in relation to duvets and pillows; and QUALLOPLUS which had previously been used in Canada in relation to duvets and pillows by licensee(s) of the opponent. As its final ground, the opponent alleged that the trade-mark QUATTREL is not distinctive in that it does not actually distinguish the wares in association with which it is proposed to be used by the applicant from those of others, namely, the opponent or its duly appointed licensees, nor is it adapted to distinguish the applicant's wares from those of the

opponent or its duly appointed licensees.

The applicant served and filed a counter statement in which it denied the allegations set forth in the statement of opposition. The opponent filed as its evidence the affidavit Wolfe G. Brehme while the applicant submitted as its evidence the affidavit of Randall Castel. Randall Castel was cross-examined on his affidavit, the transcript of the cross-examination forming part of the opposition record. Both parties submitted written arguments and an oral hearing was not requested by the parties.

From the opponent's correspondence dated May 30, 1997, it would appear that the applicant fulfilled certain of the undertakings given during the Castel cross-examination on April 24, 1997 and May 20, 1997, subsequent to the exchange of written arguments in this opposition and almost two years subsequent to the Castel cross-examination. In view of the inordinate and, in my view, unjustified delay in fulfilling the undertakings, the opponent advised the Opposition Board that it would not be filing the responses to the undertakings with the Opposition Board. The Registrar will draw negative inferences from the failure of a party to fulfil undertakings given during a cross-examination. However, a review of the transcript of the Castel cross-examination reveals that the undertakings which were given are of little relevance to the issues in this proceeding. Moreover, the entire cross-examination appeared to be pointless and certainly did not advance the opponent's case to any extent.

The first ground of opposition turns on the issue of confusion between the applicant's trade-mark QUATTREL as applied to the wares covered in the present application and the opponent's registered certification marks identified in the first ground. With respect to a ground of opposition based on Paragraph 12(1)(d) of the *Trade-marks Act*, the material date is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)]. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue as of the material date, the Registrar must have regard to all the surrounding circumstances including, but not limited to, the criteria which are specifically enumerated in Subsection 6(5) of the *Trade-marks Act*. As well, the Registrar must bear

in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between its trade-mark QUATTREL and one, or more, of the opponent's registered certification marks identified above.

The applicant's trade-mark QUATTREL as applied to comforters, duvets, cushions and pillows; insulated interlining for mens', ladies' and children's winter apparel and insulated fill for sleeping bags is inherently distinctive. Likewise, the opponent's certification marks QUALLOFIRM and QUALLOFIL are inherently distinctive as applied to the wares covered in the opponent's registrations. Further, the opponent's COMFOREL mark possesses some measure of inherent distinctiveness although it does suggest that the opponent's pillows provide comfort to the user.

The Castel affidavit establishes that the applicant's trade-mark QUATTREL has become known to some extent in Canada in association with pillows but has not become known to any extent in relation to the remaining wares covered in the present application. The Wolfe affidavit establishes that the opponent's certification mark QUALLOFIL has become known in Canada and certainly to a far greater extent than has the applicant's trade-mark QUATTREL. Further, the opponent's certification marks COMFOREL and QUALLOFIRM have also become known in Canada but not to the same extent as the opponent's QUALLOFIL mark. Thus, the extent to which the trade-marks at issue have become known weighs in the opponent's favour. Likewise, the length of time the trade-marks at issue have been in use favours the opponent, the Wolfe affidavit evidencing use of the opponent's QUALLOFIL mark in association with pillows since 1983, the QUALLOFIRM mark since 1988 in association with duvets and comforters and the certification mark COMFOREL since the spring of 1990 in association with pillows. On the other hand, the applicant commenced use of its trade-mark QUATTREL in association with pillows in 1991.

The applicant's "comforters, duvets, cushions and pillows; insulated interlining for mens', ladies' and children's winter apparel and insulated fill for sleeping bags" overlap the pillows, comforters, batting filler and insulations covered in the opponent's three registrations and there could be a potential overlap in the channels of trade associated with these wares. In this regard, in paragraph 9 of his affidavit, Mr. Wolfe refers to sales by a United States licensee of the opponent

of QUALLOFIL pillows to the applicant for resale in Canada. As well, in paragraph 8, Mr. Wolfe notes that the opponent is negotiating with the applicant for sale of COMFOREL products in Canada.

The applicant's trade-mark QUATTREL bears no similarity in appearance, sounding or in the ideas suggested to the opponent's certification mark COMFOREL. Further, the applicant's mark bears relatively little similarity either in appearance or in sounding to the opponent's QUALLOFIRM and QUALLOFIL certification marks when the marks are considered in their entireties as a matter of immediate impression. Further, the applicant's trade-mark QUATTREL and the opponent's certification marks QUALLOFIRM and QUALLOFIL do not convey similar ideas.

As a further surrounding circumstance in respect of the issue of confusion, the applicant submitted evidence of use of its trade-mark QUATTRO in association with pillows with sales in Canada from 1991 to 1994 inclusive exceeding \$9,400,000. The applicant also adduced evidence of use of the trade-mark QUATTROFIRM in association with pillows from 1991 to 1994 inclusive, the sales during this time exceeding \$3,600,000. However, in its written argument, the opponent pointed out that the applicant's registration for the trade-mark QUATTROFIRM was expunged from the register on October 4, 1996. It would appear, therefore, that the applicant may have discontinued use of the trade-mark QUATTROFIRM in Canada subsequent to 1994.

As yet a further surrounding circumstance in respect of the issue of confusion, the opponent relied upon an alleged family of certification marks in support of its position that the applicant's trade-mark QUATTREL is confusing with its marks. In this regard, the opponent has adduced evidence of use of the certification marks QUALLOFIRM in association with pillows, QUALLOFIL in association with pillows, sleeping bags, mattress pads, outerwear and duvets, and QUALLOLOFT in association with pillows and duvets. Thus, the Wolfe affidavit establishes that the opponent has a small family of marks comprising the initial element QUALLO. However, I do not consider that the certification mark COMFOREL would be perceived by the average Canadian either as being a member of this family of marks or as being related to any one of the marks comprising the family of marks. Moreover, I do not consider that the average consumer would perceive the applicant's

trade-mark QUATTREL as being associated with the opponent's family of marks, bearing in mind that the applicant has shown a fair degree of use of its trade-mark QUATTRO for pillows.

In view of the above, and bearing in mind that there is no similarity between the applicant's trade-mark QUATTREL and the opponent's registered certification mark COMFOREL, I have concluded that there would be no reasonable likelihood of confusion between these marks and have therefore rejected the Paragraph 12(1)(d) ground which is based on this mark. Further, having regard to the relatively little similarity in appearance and sounding between the trade-mark QUATTREL and the opponent's certification marks QUALLOFIRM and QUALLOFIL, I have likewise concluded that there would be no reasonable likelihood of confusion between these marks and have therefore rejected the remaining grounds of opposition based on Paragraph 12(1)(d) of the *Trade-marks Act*.

The second ground of opposition is also based on allegations of confusion between the applicant's trade-mark and the opponent's certification marks: COMFOREL which had previously been used in Canada in relation to pillows by licensee(s) of the opponent; QUALLOFIRM which had previously been used in Canada in relation to pillows, comforters, and batting filler; QUALLOFIL which had previously been used in Canada in relation to pillows, batting filler and insulations; QUALLOLOFT which had previously been used in Canada in relation to duvets and pillows; and QUALLOPLUS which had previously been used in Canada in relation to duvets and pillows by licensee(s) of the opponent. As no evidence of use of the QUALLOPLUS mark has been adduced by the opponent, I have dismissed the non-entitlement ground which is based on this mark. As well, the Wolfe affidavit does not establish that the opponent used the certification mark QUALLOLOFT in Canada in relation to either duvets and pillows prior to August 17, 1990, the applicant's filing date. On the other hand, the opponent has established its prior use and non-abandonment of its certification marks COMFOREL in association with pillows and duvets, QUALLOFIRM in association with pillows, and QUALLOFIL in association with pillows, sleeping bags, outerwear and duvets. Accordingly, the opponent has met the initial burden upon it under Subsections 16(5) and 17(1) of the *Trade-marks Act* in relation to these marks. As a result, this ground remains to be determined on the issue of confusion between the applicant's trade-mark QUATTREL and the opponent's certification marks as applied to the wares identified in the second ground of opposition

and in respect of which the opponent has shown prior use of its marks, that is, the marks COMFOREL applied to pillows, QUALLOFIRM applied to pillows and QUALLOFIL applied to pillows, batting filler and insulations.

In my view, the conclusions reached in assessing the likelihood of confusion in relation to the first ground likewise apply to the assessment of the issue of confusion in relation to the Paragraph 16(3)(a) ground of opposition even though the material time for considering this ground is the filing date of the present application. Thus, in view of the absence of any similarity between the applicant's trade-mark QUATTREL and the opponent's certification mark COMFOREL, I have concluded that there would be no reasonable likelihood of confusion between these marks. Further, in view of the limited degree of similarity in appearance and sounding between the applicant's trade-mark and the opponent's certification marks QUALLOFIRM and QUALLOFIL, I have likewise concluded that there would be no reasonable likelihood of confusion between these marks and have therefore rejected the remaining grounds of opposition based on Paragraph 16(3)(a) of the *Trade-marks Act*.

The final ground is based on the alleged non-distinctiveness of the applicant's trade-mark. As the opponent has not alleged any specific facts in relation to this ground, the opponent must be considered as relying upon the allegations of fact set forth in its first two grounds which support the non-distinctiveness ground. However, having concluded that the applicant's trade-mark is not confusing with any of the trade-marks relied upon by the opponent in its first and second grounds, I find that this ground is also unsuccessful.

Having been delegated by the Registrar of Trade-marks pursuant to Subsection 63(3) of the *Trade-marks Act*, I reject the opponent's opposition pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS DAY 2<sup>ND</sup> OF OCTOBER, 1997.

G.W.Partington,  
Chairman,  
Trade Marks Opposition Board.